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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,614	04/10/2001	Luis Eduardo Gutierrez-Sheris	25153-004	7999
32137 7590 03/16/2007 PATENT DOCKET CLERK COWAN, LIEBOWITZ & LATMAN, P.C. 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER BARTLEY, KENNETH	
			ART UNIT	PAPER NUMBER

3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/829,614

Applicant(s)

GUTIERREZ-SHERIS, LUIS
EDUARDO

Examiner

Kenneth L. Bartley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :9/10/2001,7/5/2002,6/2/2003,5/26/2004,11/12/2004,8/19/2005,11/7/2006,1/5/2007.

DETAILED ACTION

1. Claims 1-30 have been examined.

Priority

2. Examiner acknowledges preliminary amendment filed on 11/7/2005, however, it has not been perfected. If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 60/174646, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not

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extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Specification

3. The abstract of the disclosure is objected to because of length (abstract should be 150 words or less). Correction is required. See MPEP § 608.01(b).
4. The disclosure is objected to because of the following informalities: 1) in paragraph 99, the sentence containing "...BENEFICIARY DATA (fields 57)(and possibly..."; 2) reference to 1500, 1506, etc., beginning at para. 111 and ending at para. 122 should be 1400, 1406, etc. (see Fig. 15).

Appropriate correction is required.

5. The use of the trademark WINDOWS NT has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-10, 12-17, 20, and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,120,608 to Gallagher, et al., in view of U.S. Patent No. 6,039,250 to Ito and Hiroya.

Regarding applicant claim 1, 3, 8, 14, 20, 24 and 25,

- a. A method of transferring a sum of money from a customer to a beneficiary via a money-transfer service and an electronic communications network...

Gallagher, et al., discloses:

“Systems and Methods for Implementing Person-to-Person Money Exchange” (Title) and “...systems and methods for effecting online financial transactions between individuals or between individuals and entities such as banks, merchants and other companies.” (col. 1, lines 52-55);

- b. said customer accessing said money-transfer service via said electronic communications network...

“...user accesses a fund exchange server to establish an online account, which is used to transfer funds...” (col. 1, lines 57-60). Access can be via desktop computer, which can be an internet access device (col. 4, lines 46-52).

- c. transmitting a data-input document from said money-transfer service to said customer via said electronic communications network...

The fund exchange server (money-transfer service) provides the user (customer) one or more web pages for establishing accounts and initiating transactions (col. 5, lines 45-50).

- d. said customer entering transaction data into said data-input document to record the amount of said sum of money to be transferred, an identification of said customer, an identification of said beneficiary, and basic payment data for said money-transfer service to use in collecting said sum of money...

The payor (customer) “...is prompted to enter an amount of funds for transfer and identification information for the recipient...” (where the recipient is the beneficiary) (col. 7, lines 33-40). Information can also include the sender’s (identify the customer) name (col. 7, lines 60-65). Basic payment data, such as credit card information, is also provided when the account is established (col. 5, lines 64-67 and col. 6, lines 1-3).

- e. said money-transfer service collecting said sum of money in accordance with said basic payment data...

Funds are transferred to an online account from a funding account based on basic payment data (col. 5, lines 64-67 and col. 6, lines 1-3).

- f. providing said customer with a unique fund-pick-up code...

User (customer) can create an "identity confirmation query," which could be a unique code that the beneficiary must respond to (col. 7, lines 36-40).

- g. and informing said beneficiary of said unique fund-pick-up code...

The beneficiary needs to respond correctly to receive the funds, therefore, the beneficiary would have to be notified in some manner of the code.

Gallagher, et al., discloses additional system information including:

- i. a fund exchange system that includes an electronic communication network (col. 4, lines 32-36).
- ii. fund exchange server connected to the communication network (Fig. 1).

- iii. pages and forms provided by a fund exchange server for transmitting (from customer) and receiving (to beneficiary) transaction documents (Figs. 3 and 5).
- iv. a database for storing information and data (col. 5, lines 64-66).
- v. client (customer and beneficiary) devices connected to a communication network (col. 4, lines 32-36); access provided by computers and cell phones (col. 4, lines 48-52).

Although Gallagher, et al., provides for a confirmation query that can be used by a customer to transmit a unique pick-up code, he does not disclose the fund exchange server providing a pick-up code.

Ito and Hiroya, in the same field of endeavor, teach payment processes wherein they provide for a random number sequence as a security key (fund exchange server providing a pick-up code) (col. 4, lines 54-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have the fund exchange server of Gallagher, et al., provide an automated fund-pick-up code as disclosed by Ito and Hiroya, motivated by the fact that Ito and Hiroya provide for an "electronic money server" that includes a random number sequence as a security key and the fund exchange server could generate a random number and provide it to the customer as a pick-up code, thus eliminating the need for the customer to create the code (and saving time).

Regarding claims 2 and 26: The method of claim 1 wherein said electronic communications network includes the Internet, and the step of accessing said money-transfer service includes transmitting an access request from said customer to said money-transfer service via said Internet.

Gallagher provides that a fund exchange server is connected to a communication network that can include the internet (col. 4, lines 36-39).

Regarding claims 4 and 15: The method of claim 3 further including said customer having an IP (Internet Protocol) address and said money-transfer service recording said IP address in response to said customer accessing said money-transfer service.

Gallagher, et al., provides communication using the Internet by the payor (customer) with the fund exchange server which would require the fund server recording in some manner the payor's IP address (Microsoft Computer Dictionary, Microsoft Press, 5th Ed., 2002 pg. 287).

Regarding applicant claims 5 and 16: The method of claim 4 further including said money-transfer service creating a transaction record including said IP address, said transaction data and said unique fund-pick-up code.

Gallagher, et al., discloses that the user provides an e-mail address, mailing address, and/or "other information" as may be necessary, including transaction data, such as "amount to sent" (col. 5, lines 58-61

and Fig. 3). While an IP address is not specifically mentioned, it could be part of "other information" used to identify the customer.

Regarding claims 6 and 17: The method of claim 5 further including said money-transfer service transmitting a transaction confirmation request to said customer via said Internet.

Gallagher, et al., provides that payor (customer) "...is notified, preferably by an electronic message, that the payee has responded to the identity confirmation query." (col. 8, lines 23-26).

Regarding claim 7: The method of claim 6 wherein said electronic communications network includes the PSTN (Public Switched Telephone Network), and further including said customer contacting said money-transfer service via said PSTN to obtain said unique fund-pick-up code.

Gallagher et al., discloses user (customer) can use a cell phone (col. 4, lines 48-52) as well as a computer. It is well known in the art that cell phones and computers can use the PSTN.

Regarding claims 9, 10, 12, and 13:

(9) The method of claim 8 wherein the step of said customer contacting said money-transfer service via said PSTN includes said customer informing said money-transfer service of additional payment data.

(10) The method of claim 9 wherein said basic payment data includes an identification of a customer account at a payment institution, and the step of informing said money-transfer service of additional payment data includes revealing a unique payment code associated with said customer account.

(12) The method of claim 8 wherein the step of said customer entering data includes entering additional payment data.

(13) The method of claim 12 wherein said basic payment data includes an identification of a customer account at a payment institution, and the step of entering additional payment data includes entering a unique payment code associated with said customer.

Gallagher et al., allows that user can request additional money transferred to online account, by providing information such as account number, password, PIN number, etc. (col. 6, lines 26-32).

Regarding claim 27: The system of claim 26 wherein said Internet-access apparatus includes a web browser and a display, said money-transfer service includes a web-based server, and said document means includes means for transmitting said transaction documents as HTML (Hypertext Markup Language) documents capable of being rendered on said display via said web browser.

Gallagher et al., disclose that client devices include browsing programs (col. 4, lines 52-58) used on a monitor with a GUI interface (col. 4, lines 58-65). Also, "...content is typically presented to the user as a web page

**formatted according to downloaded JavaScript code and HTML code...”
(col. 5, lines 31-34).**

Regarding claim 28: The system of claim 27 wherein said electronic communications network includes the PSTN (Public Switched Telephone Network) and each of said customer communication systems includes a DTMF (Dual-Tone, Multiple Frequency) access device connected to said PSTN...

Cell phones can contain DTMF (defined by phonescoop.com/glossary).

8. Claims 11, 18, 19, 21-234, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section 7 above, in further view of Pub. No. US 2002/0029193 to Ranjan and Shah.

Regarding claims 11, 18, 19, 21-23, 29, and 30:

Although Gallagher, et al., discloses a cell phone, he does not disclose verbal communication or a method where the phone number is automatically provided (AIN).

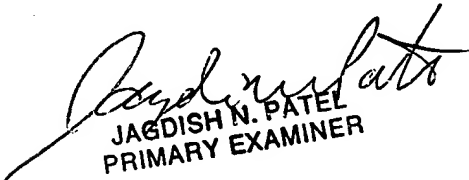
Ranjan and Shah, in the same field of endeavor, teach a payment process using telephones that include a caller ID (AIN to match with customer phone number) and voice capability (para. 39 and 45). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include an AIN and voice capability as disclosed by Gallagher and Ito, et al., as combined above, motivated by Ranjan and Shah who use such a

caller ID and voice capability to enhance security and that these features will augment the security disclosed in the combined reference in section 7, where enhanced security is important given that money transfer is involved.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth L. Bartley whose telephone number is (571) 272-5230. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jagdish Patel can be reached on (571) 272-6748. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JAGDISH N. PATEL
PRIMARY EXAMINER